



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,293	02/13/2002	Ekaterina Aleksandrovna Tabolina	US-1450	3493

38108 7590 01/11/2006  
CERMAK & KENEALY LLP  
ACS LLC  
515 EAST BRADDOCK ROAD  
SUITE B  
ALEXANDRIA, VA 22314

EXAMINER

GANGLE, BRIAN J

ART UNIT PAPER NUMBER

1645

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/073,293	TABOLINA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Brian J. Gangle	1645	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to a bacterium with enhanced activity of SEQ ID NO: 3 and 5, classified in class 435, subclass 252.33.
- II. Claims 4-14, drawn to methods for producing L-amino acids using the bacterium of group I, classified in class 435, subclass 106.
- III. Claims 15-17, drawn to a bacterium with enhanced activity of SEQ ID NO: 11, classified in class 435, subclass 252.33.
- IV. Claims 18-22, drawn to methods for producing L-amino acids using the bacterium of group III, classified in class 435, subclass 106.
- V. Claims 23-25, drawn to a bacterium with enhanced activity of SEQ ID NO: 15, classified in class 435, subclass 252.33.
- VI. Claims 26-30, drawn to methods for producing L-amino acids using the bacterium of group V, classified in class 435, subclass 106.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

Art Unit: 1645

§ 806.05(h)). In the instant case L-amino acids can be produced by the fermentation of Coryneform bacteria.

Inventions I and III are related as products. The claims of Invention I are drawn to a bacterium with enhanced activity of SEQ ID NO: 3 and 5, while the claims of Invention III are drawn to a bacterium with enhanced activity of SEQ ID NO: 11. The inventions are patentably distinct products because they are made by different methods and because they are physically and functionally distinct chemical entities with no common core structure.

The products of Invention I are separate and distinct from the methods of Invention IV, wherein the products of Invention I may neither be made by nor used in the methods of Invention IV. In the instant case, the claims of Invention I are drawn to a bacterium with enhanced activity of SEQ ID NO: 3 and 5, while the claims of Invention IV are drawn to methods for producing L-amino acids using a bacterium with enhanced activity of SEQ ID NO: 11.

Inventions I and V are related as products. The claims of Invention I are drawn to a bacterium with enhanced activity of SEQ ID NO: 3 and 5, while the claims of Invention V are drawn to a bacterium with enhanced activity of SEQ ID NO: 15. The inventions are patentably distinct products because they are made by different methods and because they are physically and functionally distinct chemical entities with no common core structure.

The products of Invention I are separate and distinct from the methods of Invention VI, wherein the products of Invention I may neither be made by nor used in the methods of Invention VI. In the instant case, the claims of Invention I are drawn to a bacterium with enhanced activity of SEQ ID NO: 3 and 5, while the claims of Invention VI are drawn to methods for producing L-amino acids using a bacterium with enhanced activity of SEQ ID NO: 15.

The products of Invention III are separate and distinct from the methods of Invention II, wherein the products of Invention III may neither be made by nor used in the methods of Invention II. In the instant case, the claims of Invention III are drawn to a bacterium with enhanced activity of SEQ ID NO: 11, while the claims of Invention II are drawn to methods for producing L-amino acids using a bacterium with enhanced activity of SEQ ID NO: 3 and 5.

Inventions II and IV are related as methods. The methods are distinct from one another because they have different goals as evidenced by different method steps (cultivating bacteria with enhanced activity of SEQ ID NO: 3 and 5; cultivating bacteria with enhanced activity of SEQ ID NO: 11) and have different final outcomes. Consequently, each method is distinct from the other.

The products of Invention V are separate and distinct from the methods of Invention II, wherein the products of Invention V may neither be made by nor used in the methods of Invention II. In the instant case, the claims of Invention V are drawn to a bacterium with enhanced activity of SEQ ID NO: 15, while the claims of Invention II are drawn to methods for producing L-amino acids using a bacterium with enhanced activity of SEQ ID NO: 3 and 5.

Inventions II and VI are related as methods. The methods are distinct from one another because they have different goals as evidenced by different method steps (cultivating bacteria with enhanced activity of SEQ ID NO: 3 and 5; cultivating bacteria with enhanced activity of SEQ ID NO: 15) and have different final outcomes. Consequently, each method is distinct from the other.

Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

Art Unit: 1645

product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case L-amino acids can be produced by the fermentation of Coryneform bacteria.

Inventions III and V are related as products. The claims of Invention III are drawn to a bacterium with enhanced activity of SEQ ID NO: 11, while the claims of Invention V are drawn to a bacterium with enhanced activity of SEQ ID NO: 15. The inventions are patentably distinct products because they are made by different methods and because they are physically and functionally distinct chemical entities with no common core structure.

The products of Invention III are separate and distinct from the methods of Invention VI, wherein the products of Invention III may neither be made by nor used in the methods of Invention VI. In the instant case, the claims of Invention III are drawn to a bacterium with enhanced activity of SEQ ID NO: 11, while the claims of Invention VI are drawn to methods for producing L-amino acids using a bacterium with enhanced activity of SEQ ID NO: 15.

The products of Invention V are separate and distinct from the methods of Invention IV, wherein the products of Invention V may neither be made by nor used in the methods of Invention IV. In the instant case, the claims of Invention V are drawn to a bacterium with enhanced activity of SEQ ID NO: 15, while the claims of Invention IV are drawn to methods for producing L-amino acids using a bacterium with enhanced activity of SEQ ID NO: 11.

Inventions IV and VI are related as methods. The methods are distinct from one another because they have different goals as evidenced by different method steps (cultivating bacteria with enhanced activity of SEQ ID NO: 11; cultivating bacteria with enhanced activity of SEQ ID

Art Unit: 1645

NO: 15) and have different final outcomes. Consequently, each method is distinct from the other.

Inventions V and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case L-amino acids can be produced by the fermentation of *Coryneform* bacteria.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to

Art Unit: 1645

retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Gangle whose telephone number is (571) 272-1181. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (571) 272-0864. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1645

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Brian Gangle  
1/05/2006

  
PATRICIA A. DUFFY  
PRIMARY EXAMINER